

REMARKS**I. General**

The following issues were raised by the present Office Action:

- Claims 1-6, 13-16, 20-22, 27, 30-35, 37-39 and 43-46 are indicated as rejected under 35 U.S.C. 102(e) as anticipated by Hu et al, U.S. Pat. No. 6,271,939 (hereinafter *Hu*);
- Claims 7-10, 17-19, 23-26, 28, 29 and 40-42 are indicated as rejected under 35 U.S.C. § 103(a) as unpatentable over *Hu*; and
- Claims 11, 12 and 36 are objected to as being dependent upon a rejected base claim.

Applicant hereby traverses the outstanding rejections of the claims, and request reconsideration and withdrawal of the outstanding rejections in light of the remarks contained herein. Claims 1-46 are currently pending in this application.

II. Status of Independent Claim 42

Although independent claim 42 is indicated as being rejected under 35 U.S.C. § 103(a), Applicant notes that it is discussed under the § 102(e) rejections. Also, a discussion of claim 42, under the § 103(a) rejection cites “remote operation capabilities” and independent claim 42 does not recite a remote operation capability, or the like. Therefore, claim 42 will be dealt with below in answering the rejections under 35 U.S.C. § 102(e).

III. Rejection(s) under 35 U.S.C. § 102(e)

As noted above , claims 1-6, 13-16, 20-22, 27, 30-35, 37-39 and 43-46 are as rejected under 35 U.S.C. § 102(e) as anticipated by *Hu*. For at least the reasons advanced below Applicant respectfully traverses these rejections.

The recited reference does not teach all claimed elements.

It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejections do not satisfy one or more of these requirements, as detailed below.

Independent claim 1 recites “scanning an electronic image of an item that is disposed between said support back and said retention pane into memory storage.” *Hu* does not disclose at least this element. As shown in FIGURES 2C and 3B of *Hu*, and discussed at column 5, lines 14 and 15 “transparent scanner 250 is placed onto scanning object 252” for scanning. Thus, *Hu* does not teach the claimed “scanning an electronic image of an item that is disposed between said support back and said retention pane.” In other words, *Hu*’s object to be scanned (252) is not disposed between a support back and a retention pane.

Independent claim 1 also recites “said frame disposed generally upright.” *Hu* appears to teach that “transparent scanner 250 is placed onto scanning object 252” in a generally horizontal configuration. See FIGURES 2C and 3B.

For at least the above reasons, Applicant respectfully asserts that independent claim 1 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, a person of ordinary skill in the art considering the prior art would not find the above differences obvious.

Claims 2-6, 13-16, 20-22, 27, and 30-32 each ultimately depend from independent claim 1, and thus inherits all elements of claim 1. Thereby, for at least the reasons advanced above in addressing the anticipation rejection of claim 1, Applicant respectfully asserts that each of claims 2-6, 13-16, 20-22, 27, and 30-32 set forth features and elements not recited by

Hu. Therefore, Applicant respectfully asserts that claims 2-6, 13-16, 20-22, 27, and 30-32 are also patentable over the 35 U.S.C. § 102 rejections of record.

Independent claim 33 recites “supporting said item to be scanned, generally upright in a frame” and “retaining said item within said frame for display and scanning.” As noted above in addressing the rejection of claim 1, *Hu* teaches that “transparent scanner 250 is placed onto scanning object 252” in a generally horizontal configuration. Therefore, *Hu* fails to teach “supporting said item to be scanned, generally upright in a frame” and “retaining said item within said frame for display and scanning.” Applicant respectfully asserts that at least for this reason independent claim 33 is also patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, a person of ordinary skill in the art considering the prior art would not find the above differences obvious.

Claims 34, 35 and 37-39 each ultimately depend from independent claim 33, and thus each of claims 34, 35 and 37-39 inherit all elements of claim 33. Thereby, for at least the reasons advanced above in addressing the anticipation rejection of claim 33, each of claims 34, 35 and 37-39 set forth features and elements not recited by *Hu*. Therefore, Applicant respectfully asserts that claims 34, 35 and 37-39 are also patentable over the 35 U.S.C. § 102 rejections of record.

The text of the § 102(e) rejection indicates that “arguments analogous to those presented for claim 1 are applicable to claims ...42...” Therefore, the rejection of claim 42 is answered here. Independent claim 42 recites “means for supporting, generally upright, an item to be scanned and displayed.” Again, as noted above, *Hu* teaches that “transparent scanner 250 is placed onto scanning object 252” in a generally horizontal configuration. Therefore, *Hu* fails to teach “means for supporting, generally upright, an item to be scanned and displayed.” Applicant respectfully asserts that at least for this reason independent claim 42 is also patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, a person of ordinary skill in the art considering the prior art would not find the above differences obvious.

Claims 43-46 each ultimately depend from independent claim 42, and thus each of claims 43-46 inherit all elements of claim 42. Thereby, for at least the reasons advanced

above in addressing the anticipation rejection of claim 42, each of claims 43-46 set forth features and elements not recited by *Hu*. Therefore, Applicant respectfully asserts that claims 43-46 are also patentable over the 35 U.S.C. § 102 rejections of record.

IV. Rejections under 35 U.S.C. §103(a)

Claims 7-10, 17-19, 23-26, 28, 29, 40 and 41 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Hu*. (As indicated above, Applicant believes the Examiner intended to reject claim 42 only under 35 U.S.C. § 102.) For at least the reasons advanced below Applicant respectfully traverses the rejections of claims 7-10, 17-19, 23-26, 28, 29, 40 and 41.

A. Examiner's Personal Knowledge

In the rejection of claims 7-10, 17-19, 23-26, 28, 29, 40 and 41, the Office Action states that various elements are "well known and routinely implemented in the art." In light of the Examiner's statement that such teachings are well known, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to these matters. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the various assertions. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite one or more references in support of the various assertions. Otherwise the rejection of claims 7-10, 17-19, 23-26, 28, 29, 40 and 41 should be withdrawn.

B. A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the second criterion, Applicant asserts that the rejection does not satisfy the first and third criteria.

1. **The recited combination does not teach or suggest all claim elements.**

The Office Action appears to implicitly admit that *Hu* does not disclose various elements of claims 7-10, 17-19, 23-26, 28, 29, 40 and 41. The Office Action attempts to cure these deficiencies by introducing Official Notice and/or Common Knowledge, which the Office Action alleges to teach such elements. However, the modifications to *Hu* advanced by the Office Action still fail to teach or suggest all elements of claims 7-10, 17-19, 23-26, 28, 29, 40 and 41.

Independent claims 1 and 33 are discussed above in addressing the anticipation rejection of each of these claims. As there noted, *Hu* fails to teach, or suggest, “scanning an electronic image of an item that is disposed between said support back and said retention pane into memory storage” or “said frame disposed generally upright,” as recited by independent claim 1. Claims 7-10, 17-19, 23-26, 28 and 29 ultimately depend from independent claim 1, and thereby each of claims 7-10, 17-19, 23-26, 28 and 29 inherit all elements of claim 1. Thus, each of claims 7-10, 17-19, 23-26, 28 and 29 set forth features and elements not recited by *Hu* as modified by the Office Action.. Therefore, Applicant respectfully asserts that at least for this reason claims 7-10, 17-19, 23-26, 28 and 29 are patentable over the 35 U.S.C. § 103(a) rejection of record.

As also noted above *Hu* fails to teach, or suggest, independent claim 33 elements “supporting said item to be scanned, generally upright in a frame” and “retaining said item within said frame for display and scanning.” Claims 40 and 41 ultimately depend from independent claim 33 and thereby each of claims 40 and 41 inherit all elements of claim 33. Thus, each of claims 40 and 41 set forth features and elements not recited by *Hu* as modified by the Office Action.. Therefore, Applicant respectfully asserts that at least for this reason claims 40 and 41 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Additionally, as discussed above, the Office Action indicates that independent claim 42 is rejected under 35 U.S.C. § 103(a). However, Applicant notes that independent claim 42 is discussed under the § 102(e) rejections in the Office Action. Therefore, Applicant has addressed independent claim 42 above, when addressing the anticipation rejections. Still, Applicant notes the discussion of claim 42 in the Office Action, under the § 103(a) rejection,

cites “remote operation capabilities.” Applicant respectfully notes that independent claim 42 does not recite a remote operation capability element, or the like.

2. The Office Action does not provide the requisite motivation.

As noted above, the Office Action implicitly admits that *Hu* does not disclose various elements of claims 7-10, 17-19, 23-26, 28, 29, 40 and 41. The Office Action attempts to cure this deficiency by introducing Official Notice and/or Common Knowledge, which the Office Action alleges to teach such elements. The motivation for making the modifications in each case was presented as follows: “it would have obvious ... to include such treatment [or feature] in *Hu*’s device.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Language such as “it would have obvious ... to include such treatment [or feature] in *Hu*’s device” is, at best, merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. In the present Office Action, no motivation has been provided at all. Rather, a mere assertion that “it would have been obvious” to make the modifications is offered. Thus, no valid suggestion has been made, absent the application of impermissible hindsight, as to why a combination of *Hu* and common knowledge is desirable. Therefore, the rejection of claims 7-10, 17-19, 23-26, 28, 29, 40 and 41 should be withdrawn.

V. Conclusion

Applicant wishes to express gratitude for the indication that claims 11, 12 and 36 include allowable subject matter. However, for at least the reasons given above, Applicant submits that the remaining pending claims distinguish over the applied art under 35 U.S.C. §§ 102 and 103. Accordingly, Applicant submits that this application is in condition for allowance.


Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10010566-1, from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can be helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482708298US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: June 6, 2005

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Respectfully submitted,

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